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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,500	02/21/2001	Guillermo Lao	111325-40	6754
22204	7590	11/02/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/788,500	LAO ET AL.	
	Examiner	Art Unit	
	Rob Rhode	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 147 - 249 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 147, 148, 149, 153, 155 - 157, 195, 199, 200, 201, 205, 207 - 209, 247 and 249 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 150 - 152, 154, 158 - 194, 196 - 198, 202 - 204, 206, 210 - 246 and 248 .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-08-05 has been entered.

Response to Amendment

Applicant's election without traverse of the Restriction Requirement in the reply filed on 8-18-05 is acknowledged.

Claims 150 – 152, 154, 158 – 194, 196 – 198, 202 – 204, 206, 210 – 246 and 248 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species. Applicant timely traversed the restriction (election) requirement in the reply filed on 8-18-05. Applicant argued that the species restriction was improper because the invention has a single embodiment. It was noted in the Restriction Requirement that should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

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unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. However, the Applicant did not submit any evidence/arguments to demonstrate that the species are obvious variants.

Thereby, the requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The information disclosure statement filed 8-18-05 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a copy of the European Search Report was not included. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding Claims 147, 199 and 249 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 147 for example, the

phrase "accompanying conditions " is a relative phrase, which renders the claims indefinite. The phrase " accompanying conditions " is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the phrase "accompanying conditions" will be treated as rights conditions.

Regarding claims 148 and 200, these Claims recites the limitation "consumer". There is insufficient antecedent basis for this limitation in the claim. For example is the consumer the same as a " user", which is recited in claim 147?

Regarding claims 148 and 200 as well as Claims 156 and 208 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example and with the Applicant's use of "and/or", this use of "and/or" makes the determination of the metes and bounds of the claim almost impossible.

Regarding 157 and related claim 209, these Claims recite the limitation "template". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 147, 148, 149, 153, 155 – 157, 195, 199, 200, 201, 205, 207 – 209, 247 and 249 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 6,938,021 B2) in view of Spagna (US 6,587,837 B1).

Regarding claims 147 and related claims 199 and 249, Shear teaches a method and system for publishing content, the method comprising:

receiving, by a publishing system, a selection of content from a user of said publishing system, said selection identifying an item of content;

receiving by said publishing system a request to publish the selected content from the user of said publishing system;

providing, by said publishing system in response to the request from the user to publish the content, information to distributor system, said information comprising at least one of a description of the content, metadata of the content, content identifiers, publisher information, content repository indication and a rights specification identifier;

upon receiving the information said distributor system generating a response using said provided information and predefined rules stored in a database, said predefined rules for determining whether the distributor system is interested in the content specified by said provided information;

providing by said distributor system, the response to said publishing system;

determining, by said publishing system, whether the response indicates that the distributor system is interested in the content specified by said provided information; and only if said publishing system has determined that the distributor system is interested

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in the content specified by said provided information, supplying by said publishing system, metadata and a rights specification to said distributor system, said metadata being identification and descriptive data of said content and said rights specification being at least one of access rights, usage rights and accompanying conditions (see at least Abstract, Col 7, lines 36 – 53, Col 8, lines 46 – 55, Col 9, lines 28 – 31, Col 12, lines 55 – 67, Col 15, lines 20 – 25 and lines 54 – 63, Col 16, lines 48 – 54, Col 19, lines 4 – 65, Col 20, lines 2 – 13, Col 33, lines 5 – 15, Col 53, lines 11 – 19, Col 56, lines 63 – 67, Col 57, lines 1 – 7, Col 58, lines 5 – 11).

Please note that a publisher was treated as a “content provider” for examination purposes.

While Shear does disclose a publisher and a distributor as well as vertical markets with either hierarchy or peer to peer relationships, the reference does not specifically disclose the specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor.

On the other hand and in the same area of providing content with rights specification, Spagna discloses and teaches a method and system for the specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor (see at least Abstract, Col 12, lines 23 – 33, Col 13, lines 13 – 22 and lines 55 – 67 and Figure 6).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Shear with the method and system of Spagna to have enabled a method and system for the specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor. Shear discloses a method and system as recited in claim 1, except for a specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor. In turn, Spagna discloses a method and system for the specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor (see at least Abstract, Col 12, lines 23 – 33, Col 13, lines 13 – 22 and lines 55 - 67 and Figure 6). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Shear with a method and system for the specific relationship of a publisher (content provider) and the providing of content from the publisher to the distributor. In this manner, the distributor is provided the capability to automatically filter the content pushed to them and indicate the only ones that are of interest to them currently and thereby reduce the time required to review all the content pushed to them.

Regarding claim 148 and related claim 200, Shear teaches a method and system, wherein the distributor system further uses pre-defined rules to narrow the rights defined by the rights specification and/or change conditions defined by the rights specification, resulting in a customized rights to offer a consumer (Col 28, lines 40 – 44).

Regarding claim 149 and related claim 201, Shear teaches a method and system, wherein the pre-defined rules comprise at least one of content type preferences, rights and conditions, preferences, content topics and publishers (Col 19, lines 4 – 7 and lines 58 – 65).

Regarding claim 153 and related claim 205, Spagna teaches a method and system whereon the rights specification includes at least one of the right to print, view, play, extract, and export (Col 6, lines 1 – 4).

Regarding claim 155 and related claim 207, Spagna teaches a method and system, further comprising creating by the publishing system, the rights specification (Col 12, lines 52 - 56).

Regarding claim 156 and related claim 208, Spagna teaches a method and system wherein the rights specification is created by the publishing system, based upon user profile, a default rights specification, inference rules, and/or an analysis of the selected content (Col 12, lines 52 - 56).

Regarding claim 157 and related claim 209, Spagna teaches a method and system, wherein the rights template includes at least one usage right and a condition upon which the usage right is contingent (Col 12, lines 24 – 33 and lines 54 – 56).

Regarding claim 195 and related claim 247, Spagna teaches a method and system, wherein the rights specification includes information regarding specific rights granted to the content if a given set of conditions is satisfied (Col 12, lines 54 - 56).

Response to Arguments

Applicant's arguments with respect to claims 147 - 249 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

After Final communications labeled

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"Box AF"]


For general questions the receptionist can be reached at

571.272.3600

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). RER



Jeffrey A. Smith
Primary Examiner